

Exhibit H

Oct 19 Section 341 mtg.txt

IN THE UNITED STATES BANKRUPTCY COURT  
FOR THE NORTHERN DISTRICT OF ILLINOIS  
EASTERN DIVISION

Leo Stoller,	)	05 B 64075
	)	Chicago, Illinois
	)	1:00 p.m.
Debtor.	)	October 20, 2006

TRANSCRIPT OF PROCEEDINGS BEFORE THE  
CHAPTER 7 TRUSTEE RICHARD FOGEL

APPEARANCES:

For Debtor:	Mr. Richard Golding;
For Pure Fishing:	Mr. Wm. Factor;
For U.S. Trustee:	Mr. David Gucwa;

Oct 19 Section 341 mtg.txt

2

1 MR. FOGEL: This is the continued 341  
2 meeting in the converted Chapter 13 case of Leo  
3 Stoller, S-t-o-l-l-e-r, 05 B 64075. My name is  
4 Richard Fogel. I am the case trustee for the Stoller  
5 estate. To my right is Janice Alwin, one of my  
6 counsel.

7 Counsel for debtor, would you please  
8 state your name?

9 MR. GOLDING: Richard Golding.

10 MR. FOGEL: Who else appears, please?

11 MR. FACTOR: William Factor on behalf  
12 of creditor Pure Fishing.

13 MR. FOGEL: Sir?

14 MR. GUCWA: David Gucwa on behalf of  
15 the U.S. Trustee's office.

16 MR. FOGEL: Sir?

17 THIRD SPEAKER: (Unintelligible) for  
18 creditor.

19 MR. FOGEL: Very good.

20 Sir, would you state your name?

21 MR. STOLLER: Leo Stoller.

Oct 19 Section 341 mtg.txt

22 MR. FOGEL: Do you have a photo I.D.?

23 MR. STOLLER: No, I don't.

24 MR. FOGEL: Do you have proof of your  
25 social security number?

3

1 MR. STOLLER: I do.

2 MR. FOGEL: May I see it?

3 MR. STOLLER: I don't have it with me.

4 MR. FOGEL: Mr. Golding, does your  
5 client know that he has to provide a photo I.D. and  
6 proof of his social security number?

7 MR. GOLDING: I did not remind him.

8 MR. STOLLER: I can get that for you.

9 MR. FOGEL: I will proceed on the  
10 representation that the debtor will provide the  
11 information to counsel, and I know counsel will  
12 forward it on to me. So that would be a photo I.D.  
13 and social security number.

14 (Witness sworn.)

15 LEO STOLLER, WITNESS, SWORN

16 EXAMINATION

17 BY MR. FOGEL:

18 Q Mr. Stoller, did you file a Chapter 13  
19 bankruptcy case on December 20th of 2005?

Oct 19 Section 341 mtg.txt

20           A     Upon the advice of my attorney I'm taking  
21 the Fifth Amendment to all questions that are being  
22 asked.

23           Q     Mr. Stoller, I show you a declaration  
24 regarding electronic filing. Is that your signature?

25           A     Upon the advice of my attorney I'm taking  
4

1 the Fifth Amendment to all questions that are being  
2 asked.

3                     MR. GOLDING: The debtor will take the  
4 Fifth Amendment as to any and all questions that are  
5 presented other than for his name and address.

6                     For the record, there -- any further  
7 questions will be answered the same way. And that is  
8 the result of certain statements that have been made  
9 to counsel for the debtor in this case.

10 BY MR. FOGEL:

11           Q     Mr. Stoller, have you turned over to me any  
12 and all recorded information including books,  
13 documents, records and papers that you have relating  
14 to property of the estate?

15           A     I decline to answer that question on the  
16 grounds of the Fifth Amendment.

17                     MR. FOGEL: Mr. Golding, have you

Oct 19 Section 341 mtg.txt

18 discussed with your client the fact that under  
19 Section 521(4) of the Bankruptcy Code the debtor  
20 shall provide the items I just requested information  
21 about whether or not immunity is granted under  
22 Section 344?

23 MR. GOLDING: Yes.

24 MR. FOGEL: And he is still not going  
25 to answer the question?

5

1 MR. GOLDING: He's not going to answer  
2 the question. He may provide the information, but  
3 he's not going to answer the question.

4 BY MR. FOGEL:

5 Q Mr. Stoller, do you have any recorded  
6 information including books, documents, records and  
7 papers?

8 A I'm going to decline to answer the question  
9 on the grounds of the Fifth Amendment.

10 Q Mr. Stoller, on your schedules you  
11 indicated that you were a shareholder and in other  
12 documents you have indicated you were an officer of  
13 certain corporate entities. Do you have any  
14 corporate records regarding any of those entities?

15 A I'm going to decline to answer that

Oct 19 Section 341 mtg.txt

16 question on the advice of counsel based on my Fifth  
17 Amendment rights.

18 MR. FOGEL: Mr. Golding, have you  
19 discussed the case of Braswell versus the United  
20 States --

21 MR. GOLDING: I have not.

22 MR. FOGEL: -- with your client?

23 MR. GOLDING: I have not.

24 MR. FOGEL: In case you have  
25 forgotten, the cite is 487 U.S. 99, in which an

6

1 individual who has corporate records must produce,  
2 cannot resist a subpoena on the ground that the act  
3 of production would be incriminating.

4 MR. GOLDING: Did you subpoena any  
5 documents?

6 MR. FOGEL: I don't have to because  
7 the debtor has a duty under 521 to produce the  
8 documents.

9 MR. GOLDING: Well --

10 MR. FOGEL: I'm just bringing this to  
11 your attention, sir.

12 MR. GOLDING: You're citing a case and  
13 telling me it provides that pursuant to a subpoena.

Oct 19 Section 341 mtg.txt

14 You didn't subpoena him, so I'm not sure if there's a  
15 relevance to the case.

16 MR. FOGEL: You're probably right.

17 MR. GOLDING: But do you want to give  
18 me the cite again?

19 MR. FOGEL: No. I will give it to you  
20 later.

21 BY MR. FOGEL:

22 Q Mr. Stoller, what domain names do you own?

23 A I'm going to decline to answer that  
24 question on the advice of counsel and my Fifth  
25 Amendment rights.

7

1 Q Mr. Stoller, do you have any licenses with  
2 any entities by the names either Epsco (phonetic)  
3 Lindy-Little Joe, Jas. D. Easton, Inc., MD  
4 Manufacturing, Inc.?

5 A I'm going to decline to answer that  
6 question on my Fifth Amendment rights and upon the  
7 advice of counsel.

8 Q Mr. Stoller, do you own any real estate?

9 A I decline to answer that question on my  
10 Fifth Amendment rights.

11 Q Mr. Stoller, when you filed your bankruptcy



Oct 19 Section 341 mtg.txt

12 petition in December of '05, you indicated a bank  
13 account at Bank of America. Do you know the account  
14 number?

15 A I'm going to decline to answer that  
16 question on my Fifth Amendment rights.

17 Q Mr. Stoller, in your schedules you have  
18 identified five corporate entities that you claim to  
19 be the sole shareholder of. Do you have proof of  
20 ownership of any of those companies?

21 A I'm going to decline to answer that  
22 question on my Fifth Amendment rights.

23 Q Mr. Stoller, you have indicated that you  
24 had trademarks worth \$36,000 on the day you filed  
25 your bankruptcy case. Do you have any documentation

8

1 relating to those trademarks?

2 A I decline to answer that question on my  
3 Fifth Amendment rights.

4 MR. GOLDING: You know, there really  
5 is no need to continue to ask all the questions. He  
6 will answer it the same way. We will stipulate that  
7 you will ask all the questions and that he will  
8 answer by exercising his Fifth Amendment rights to  
9 any and all questions other than his name and

Oct 19 Section 341 mtg.txt

10 address.

11 He's doing so because it has been  
12 suggested that this matter would be referred to the  
13 United States Attorney's office by the trustee. So  
14 there is really no need for us to go through the sham  
15 of having to actually ask each question and not -- we  
16 will stipulate that you will ask all the questions  
17 and that the debtor will respond accordingly.

18 MR. FOGEL: I expected that you would  
19 say that, sir, but not all of the questions that I am  
20 asking have answers that might lead to incriminating  
21 statements. And, therefore, you cannot take a  
22 blanket assertion of the Fifth Amendment. You must  
23 assert it in response to every question I ask, and  
24 then we can later determine which are proper  
25 assertions and which are improper assertions, if any

9

1 of them are improper.

2 I'm sorry, I've been instructed to do  
3 it the way I'm doing it.

4 MR. GOLDING: Okay.

5 MR. FOGEL: I appreciate that. Thank  
6 you.

7 BY MR. FOGEL:

Oct 19 Section 341 mtg.txt

8 Q Mr. Stoller, how many bank accounts besides  
9 Bank of America do you have?

10 A I decline to answer that question on the  
11 grounds of my Fifth Amendment rights.

12 Q Have you made any payments to legal counsel  
13 since your Chapter 13 case was filed?

14 A I'm going to decline to answer that  
15 question on the grounds of my Fifth Amendment rights.

16 Q Did you receive \$20,000 from your  
17 soon-to-be ex-wife's estate in connection with  
18 payment of legal fees?

19 A I'm going to decline to answer that  
20 question on the grounds of my Fifth Amendment rights.

21 Q Do you have any credit cards?

22 A I'm going to decline to answer that  
23 question based on the grounds of my Fifth Amendment  
24 rights.

25 Q Where are you currently living?

10

1 A My address is 7815 Westwood Drive.

2 Q In Chicago, Illinois?

3 A Elmwood Park.

4 Q Is that a house or an apartment?

5 A House.

Oct 19 Section 341 mtg.txt

6 Q Do you have any ownership interest in it?

7 A No.

8 Q Who does?

9 A My wife.

10 Q What's your wife's name?

11 A Nancy Reich, R-e-i-c-h.

┌ 12 Q Have you received any income from any  
13 advertisers on the Rentamark web site in the last six  
14 months?

15 A I'm going to decline to answer that  
└ 16 question on the grounds of my Fifth Amendment rights. ┘

17 Q Have you sold any address lists to any  
18 third parties since the commencement of your  
19 bankruptcy case?

20 A I decline to answer that question on the  
21 grounds of my Fifth Amendment rights.

22 Q Have you ever owned or operated a business  
23 that provided goods or services to any clients,  
24 customers or third parties?

25 A I decline to answer that question on the

11

1 grounds of my Fifth Amendment rights.

2 Q Do you have any employees?

3 A I decline to answer that question on the

Oct 19 Section 341 mtg.txt

4 grounds of my Fifth Amendment rights.

5 Q What's your current source of income?

6 A I'm going to decline to answer that

7 question on the grounds of my Fifth Amendment rights.

8 Q Where are the computers that you used to

9 use when you were in business on Belmont?

10 A I decline to answer that question on the

11 grounds of my Fifth Amendment rights.

12 Q Where's the checkbook for the checking

13 account at First Security Bank in the name of Chemico

14 (phonetic) Manufacturing Company, Inc.

15 A I have no idea. I'm going to decline to

16 answer that question on the grounds of my Fifth

17 Amendment rights.

18 Q What issues are you appealing from in the

19 Pure Fishing case before Judge Lindberg?

20 A I'm going to decline to answer that

21 question on the grounds of my Fifth Amendment rights.

22 Q When was the last time you were at 1212

23 North Lathrop Street?

24 A I decline to answer that question on the

25 grounds of my Fifth Amendment rights.

12

1 Q How did you feel last week when you found

Oct 19 Section 341 mtg.txt

2 out that I stopped the sale of that property?

3 A I'm going to decline to answer on the  
4 grounds of my Fifth Amendment rights.

5 MR. FOGEL: Mr. Factor, do you have  
6 any questions?

7 MR. FACTOR: Yes.

8 EXAMINATION

9 BY MR. FACTOR:

10 Q Mr. Stoller, have you committed any  
11 bankruptcy fraud in the last year?

12 A I will decline to answer that question on  
13 the grounds of my Fifth Amendment rights.

14 Q Mr. Stoller, is the information in your  
15 bankruptcy schedules accurate?

16 A I'm going to decline to answer that  
17 question on the grounds of my Fifth Amendment rights.

18 Q Mr. Stoller, did you conceal your interest  
19 in the 1212 North Lathrop property in River Forest?

20 A I will decline to answer that question on  
21 the grounds of my Fifth Amendment rights.

22 Q Mr. Stoller, the information about income  
23 that you reported in the bankruptcy schedules, is  
24 that correct?

25 A I'm going to decline to answer that

Oct 19 Section 341 mtg.txt

13

1 question on the grounds of my Fifth Amendment rights.

2 Q Mr. Stoller, have you disclosed all the  
3 interests in properties that you held as of the date  
4 you filed for Chapter 13?

5 MR. GOLDING: The trustee asked that  
6 question. It's already been responded to by the  
7 exercise of his Fifth Amendment rights.

8 BY MR. FACTOR:

9 Q Mr. Stoller, is it accurate to say that you  
10 engaged in trademark trafficking?

11 A I'm going to decline to answer that  
12 question on the grounds of my Fifth Amendment rights.

13 Q Mr. Stoller, it's true, is it not, that you  
14 do not have any interest in the Stealth trademark?

15 A I'm going to decline to answer that  
16 question on the grounds of my Fifth Amendment rights.

17 Q Mr. Stoller, it's true, is it not, that no  
18 company that you have an interest in has any rights  
19 in the Stealth trademark?

20 MR. GOLDING: I'm going to object to  
21 the continuing line of questions that ask for legal  
22 conclusions. I'm letting it go, you know, a little  
23 bit here, but all these questions are objectionable

Oct 19 Section 341 mtg.txt

24 anyhow; they require a legal conclusion. The witness  
25 is here and he would testify as to facts and not as  
14

1 to legal conclusions.

2 Do you have any other questions?

3 MR. FACTOR: You're instructing him  
4 not to answer?

5 MR. GOLDING: I am.

6 BY MR. FACTOR:

7 Q Mr. Stoller, it is true, is it not, that  
8 you have manufactured claims of ownership of  
9 trademarks in order to extort money from businesses?

10 A I'm going to decline to answer that  
11 question on the grounds of my Fifth Amendment rights.

12 MR. FACTOR: I have no other questions  
13 at this time.

14 MR. GUCWA: No questions.

15 MR. FOGEL: Mr. Golding, before we  
16 conclude for the day, have you discussed with the  
17 debtor his obligations under Rule 1019 to file a  
18 final report?

19 MR. GOLDING: I have not, but I don't  
20 know if Mr. Kaplan has. But I will.

21 MR. FOGEL: Mr. Kaplan has filed a



Oct 19 Section 341 mtg.txt

22 motion to withdraw is my understanding.

23 MR. GOLDING: I'm aware of that, but I  
24 don't know if --

25 MR. FOGEL: Are you planning to file a  
15

1 motion to withdraw as well or are you planning to  
2 represent the debtor?

3 MR. GOLDING: It's under  
4 consideration.

5 MR. FOGEL: I will continue the  
6 meeting today for four weeks. I don't know if anyone  
7 has a calendar.

8 MR. GOLDING: I do.

9 MR. FOGEL: I will continue the  
10 meeting to November 17th at 1:00 o'clock to see how  
11 certain other matters play out in connection with  
12 this case.

13 Please get me a copy of his photo I.D.  
14 and proof of his social security number at your  
15 convenience.

16 Please file the report under  
17 1019(5)(b) at your earliest convenience. Thank you  
18 for attending.

19 MR. GOLDING: Thank you, Mr. Fogel.

Oct 19 Section 341 mtg.txt

20 (Which were all the proceedings had in  
21 the above-entitled cause, October 20,  
22 2006, 1:00 p.m.)

23 I, JACKLEEN DE FINI, CSR, RPR, DO HEREBY  
24 CERTIFY THAT THE FOREGOING IS A TRUE AND  
25 ACCURATE TRANSCRIPT OF THE AUDIO TAPED  
PROCEEDINGS HAD IN THE ABOVE- ENTITLED CAUSE.



**UNITED STATES DISTRICT COURT  
FOR THE Northern District of Illinois – CM/ECF LIVE, Ver 2.5  
Eastern Division**

Central Mfg. Co., et al.

Plaintiff,

v.

Case No.: 1:05-cv-00725

Honorable George W. Lindberg

Pure Fishing, Inc., et al.

Defendant.

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**NOTIFICATION OF DOCKET ENTRY**

This docket entry was made by the Clerk on Tuesday, December 12, 2006:

MINUTE entry before Judge George W. Lindberg :Mr. Stoller's motion to object to the agreed Rule 54.3(a) joint statement [256] will not be heard on 12/13/06 because Mr. Stoller failed to comply with the court's three-day notice requirement for the presentment of all motions. Further, the motion to object to the agreed Rule 54.3(a) joint statement [256] is denied as moot because the court entered the agreed order before it received the instant motion. Mailed notice(slb, )

**ATTENTION:** This notice is being sent pursuant to Rule 77(d) of the Federal Rules of Civil Procedure or Rule 49(c) of the Federal Rules of Criminal Procedure. It was generated by CM/ECF, the automated docketing system used to maintain the civil and criminal dockets of this District. If a minute order or other document is enclosed, please refer to it for additional information.

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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

Kuhlke

Mailed: September 29, 2004

Opposition No. 91159950

Central Mfg. Co.

v.

Premium Products, Inc.

Before Hanak, Bucher and Bottorff, Administrative Trademark  
Judges.

By the Board:

On July 27, 2004, the Board suspended proceedings pending disposition of several motions including opposer's motion for summary judgment. This case now comes up for consideration of the following motions: (1) opposer's motion (filed April 30, 2004) to strike applicant's affirmative defenses; (2) applicant's motion (filed May 4, 2004) to strike certain paragraphs from the notice of opposition; (3) applicant's motion (filed May 4, 2004) for protective order concerning filing and service of motions and other papers before the Board; (4) opposer's motion (filed June 7, 2004) for sanctions under Fed. R. Civ. P. 11; and (5) applicant's motion (filed July 13, 2004) for discovery under Fed. R. Civ. P. 56(f).

IT IS HEREBY ORDERED:

Opposition No. 91159950

(1) Opposer's motion to strike applicant's affirmative defenses is denied as to paragraphs nos. 1, 2 and 4 and granted, in part, as to paragraph no. 3.<sup>1</sup>

Fed. R. Civ. P. 12(f) provides for the striking from a pleading of any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. However, motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. See *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co., Inc.*, 177 USPQ 401 (TTAB 1973).

Paragraphs nos. 1, 2 and 4 are sufficient inasmuch as they serve to amplify the denials in the answer and/or apprise opposer with greater particularity of the position which applicant is taking in the defense of its right to registration.

Paragraph no. 3 reads as follows:

Opposer's opposition to PREMIUM's use and registration of the mark "GROUND ZERO STEALTH" is barred by the doctrines of waiver, estoppel, acquiescence, ratification, laches and, concerning applications identified in the Notice of Opposition, abandonment.

Opposer argues that "abandonment" should be stricken because it "represents a collateral attack on opposer's said marks." In response, applicant argues that although the Board does not permit "an attack on a registration" absent a

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<sup>1</sup> Applicant's amended answer filed on May 4, 2004 as a matter of course under Fed. R. Civ. P. 15(a) is noted. The motion to strike has been considered in the context of the amended answer.

Opposition No. 91159950

counterclaim, this "does not apply where the opposer attempts to assert a mark that is only the subject of a pending application rather than a registration."

While this may not be a collateral attack on a registration, the "affirmative defense" of abandonment is not supported by sufficient allegations (e.g., no allegation that pleaded applications have been abandoned).<sup>2</sup> In the event this defense is anticipating any future possible abandonment of pleaded applications, such an allegation would be premature and not appropriate. In view thereof, the clause "and, concerning applications identified in the Notice of Opposition, abandonment" of paragraph no. 3 of the affirmative defenses in the amended answer is hereby stricken.

Applicant is allowed until **THIRTY DAYS** from the mailing date of this order to file an amended answer which cures the deficiencies in paragraph no. 3 of the affirmative defenses, failing which proceedings will go forward with applicant's amended answer in accordance with this order.

(2) Applicant's motion to strike certain paragraphs from opposer's notice of opposition is denied as untimely, Fed.

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<sup>2</sup> With regard to the defenses of waiver, estoppel, acquiescence, ratification and laches, applicant is advised that laches and acquiescence are generally not available as defenses in an opposition proceeding. See *National Cable Television Ass'n v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991); and *DAK Industries, Inc. v. Daiichi Kosho Co.*, 25 USPQ2d 1622 (TTAB 1992).



Opposition No. 91159950

R. Civ. P. 12(f), and the Board declines, on its own initiative, to strike matter from the notice of opposition.<sup>3</sup> TBMP § 506.02 (2d ed. rev. 2004).

(3) Applicant's motion for protective order concerning filing and service of motions is granted for the reasons set forth below.

In support of its motion, applicant states that opposer's mailings do not include a postmark, which should appear in the postage meter stamp. Applicant further states, that it is against postal regulations to mail an envelope without a date postmarked thereon, quoting the U.S. Postal Services' Domestic Mail Manual wherein it states that the date of mailing must be included on a printed postage meter stamp. Applicant states that according to "officials of the U.S. Postal Service...it is apparent that the envelope in question was deposited in an outside mailbox where it would not be entered into the computer system of the Postal Service," and as such could not be tracked on their web site. Applicant is concerned that "[g]iven Mr. Stoller's [opposer's representative] long documented history

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<sup>3</sup> Moreover, a cursory review of the disputed paragraphs when taken in the context of all the allegations in the notice of opposition appear to set forth a claim of fraud in the procurement of a registration. See *Hank Thorp, Inc. v. Minilite, Inc.*, 474 F.Supp. 228, 205 USPQ 598 (D.Del. 1979); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1999 (TTAB 1999). See also See McCarthy, J. Thomas, *McCarthy on Trademarks and Unfair Competition*, §§31:71 and 31:73 (4<sup>th</sup> ed. 2004).

Opposition No. 91159950

before the Board," opposer's ability to serve filings without a mailing date postmark on the envelope could result in prejudice to applicant by, for example, shortening a deadline for response to a motion. Applicant has submitted several Board orders from several cases where Mr. Stoller was the representative for parties that have been sanctioned due to improprieties with mailings, a copy of the Domestic Mail Manual of the U.S. Postal Service, and copies of the envelopes in which opposer's filings were mailed.

In response, opposer does not dispute that there is no postmark on the envelope or that a mailing date is required to be stamped on the envelope in the meter stamp, nor does opposer dispute that it deposited the envelope in an outside mailbox, thus circumventing entry into the Postal Service computer system. Rather, opposer argues that applicant has not been harmed, yet, as evidenced by the date of receipt on the return certificate signed by applicant and states that in the two instances cited by applicant opposer mailed the documents on the "date of certification." Attached to opposer's response are copies of the postmarked return receipts for the certified mailings showing when applicant received the mailings but, notably, not when opposer mailed them.

The Board first notes that the motion for protective order is more in the nature of a motion for sanctions and the Board grants this motion both under the provisions governing protective orders and under its inherent authority

Opposition No. 91159950

to sanction bad-faith conduct and control the conduct of parties in proceedings. Trademark Rule 2.120(f); Fed. R. Civ. P. 26(c); *Central Mfg. Inc. v. Third Millenium Technology, Inc.*, 61 USPQ2d 1210 (TTAB 2001). See also *Chambers v. NASCO, Inc.*, 501 U.S. 32, 111 S.Ct. 2123, rehearing denied, 501 U.S. 1269, 112 S.Ct. 12 (1991).

In another proceeding involving Mr. Stoller, opposer's representative, the Board found that a certificate of mailing and certificate of service submitted by Mr. Stoller's former company, S. Industries, was fraudulent. *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293 (TTAB 1997). The Board made this determination based on the evidence presented which included the envelope containing plaintiff's filings that had a postage meter stamp date of July 9, 1997, rather than the certificate of mailing date of July 3, 1997.

Here, it appears from the record that opposer has found a way to circumvent this fate by simply omitting the postage meter stamp date and avoiding the postage cancellation date. Applicant's allegations regarding the omission of a postmark, or date of mailing on the envelope in apparent violation of Postal Service regulations stand un rebutted. The Board is hard pressed to think of a more egregious act of bad faith than flouting the United States Postal Service regulations. Opposer's contention that applicant has not been harmed because it timely received these filings is not correct. Applicant and the judicial process have been

Opposition No. 91159950

harmd inasmuch as opposer has made it impossible to verify the certificate of mailing statements by somehow omitting the date of mailing from its envelopes and in so doing may have violated U.S. Postal regulations during the course of this proceeding.

In view thereof, the Board grants the motion for protective order to the extent that opposer is hereby ordered to obtain a postmark from a postal official at a U.S. Post Office for all further correspondence to applicant and to the Board in this proceeding. The Board declines at this time to impose the other requirements requested by applicant.

(4) Opposer's motion for sanctions under Fed. R. Civ. P. 11 is denied.

By its motion, opposer contends that applicant's motion for a protective order filed on May 4, 2004 is frivolous and requests that the Board enter judgment against applicant. Inasmuch as the Board has now granted that motion, it is, as a matter of law, not frivolous.

(5) Applicant's motion for discovery under Fed. R. Civ. P. 56(f) and imposition of the Board's standard protective agreement is granted.

Opposer has filed a motion for summary judgment on its claim of likelihood of confusion under Section 2(d) of the Trademark Act. In the notice of opposition, opposer alleged

Opposition No. 91159950

prior common law use and pleaded several registrations and applications. Opposer relies on these pleaded marks in its motion for summary judgment.

In support of its motion for discovery, applicant states that prior to the filing of the motion for summary judgment, applicant served opposer with discovery requests but opposer's responses were inadequate. Specifically, applicant seeks discovery "to determine whether opposer owns the trademark rights opposer claims to hold in this opposition proceeding or whether, alternatively, any rights that opposer might have held are abandoned." Further, applicant states that "[t]his information will permit applicant to determine whether an issue of fact exists as to the validity of some or all of the registrations, asserted by opposer in this opposition proceeding, that would preclude entry of summary judgment" and that "[a]pplicant will seek cancellation of any and all of opposer's marks for which opposer fails to meet their burden concerning use and validity." In addition, applicant seeks discovery on the du Pont factors with regard to the likelihood of confusion analysis.

Applicant has requested that the Board: (1) impose its standard protective agreement to facilitate the exchange of confidential material; (2) order opposer to provide complete and proper responses to interrogatories nos. 1, 2, 3, 5, 6, 7, 8, 10, 15 and 17 under oath; (3) order opposer to provide documents in response to document requests nos. 1, 3 and 4;

**Opposition No. 91159950**

(4) order opposer to respond to applicant's second set of interrogatories under oath; and (5) order Mr. Leo Stoller to attend a deposition at a date, time and place agreed to between the parties after applicant receives the requested discovery.

In opposition to the motion, opposer argues that applicant's request "fail[s] to identify with particularity the information that the applicant claims it must have prior to respond [sic] to opposer's motion for summary judgment." Further, opposer argues that opposer's "ownership of the marks asserted in the opposition is not an issue in this case." Finally, opposer states that it has fully responded to the requests and many of the requests are "irrelevant to applicant's ability to file its response to opposer's motion for summary judgment."

A party that believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board for time to take the needed discovery. TBMP § 528.06. The motion should set forth with specificity the areas of inquiry needed to obtain the information necessary to enable a party to respond to the motion for summary judgment. *Id.* If a party has demonstrated a need for discovery which is reasonably directed to facts essential to its opposition to the motion, discovery will be permitted. See *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). This is especially true if the

Opposition No. 91159950

information sought is largely within the control of the party moving for summary judgment. See *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989). Finally, a party may seek information on any matter which might serve as the basis for an additional claim, defense, or counterclaim. See *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 579 (TTAB 1975) (information concerning possible abandonment, if revealed, may provide basis for counterclaim). TBMP § 402.01. Although a party may not defend against a motion for summary judgment by asserting the existence of genuine issues of material fact as to an unpleaded claim or defense, a party may move to amend its pleading to allege the matter at the time it responds to the motion for summary judgment. TBMP § 528.07(b).

Notwithstanding opposer's objections, applicant has set forth with specificity the areas of inquiry needed to obtain the information necessary to enable it to respond to the motion for summary judgment. Applicant has requested supplemental responses to specific discovery requests that address the issues of opposer's ownership and validity of the pleaded marks and certain *du Pont* factors in the likelihood of confusion analysis. Applicant has shown that opposer's responses to applicant's first set of discovery requests are inadequate and require supplementation, and that opposer has not yet responded to applicant's second set of interrogatories which are relevant to the motion for

Opposition No. 91159950

summary judgment. In addition, the Board notes that applicant has not yet had an opportunity to depose opposer on the validity and ownership of the pleaded marks. Therefore, it would be inappropriate to decide the motion for summary judgment without allowing applicant to receive relevant discovery. See *Opryland USA Inc. v. The Great American Music Show Inc.*, 23 USPQ2d 1471 (Fed. Cir. 1992) citing *Celotex v. Catrett*, 106 S. Ct. 2548 (1986) and *Dunkin' Donuts of America Inc. v. Metallurgical Exoproducts Corp.*, 6 USPQ2d 1026 (Fed. Cir. 1988).

Accordingly, the Board hereby imposes its standard protective agreement forwarded herewith. Opposer is allowed until **TWENTY FIVE DAYS** from the mailing date of this order to serve complete responses to: (1) interrogatories nos. 1,<sup>4</sup> 2, 3<sup>5</sup> 5, 6, 7, 8, 10, 15 and 17 in the first set of interrogatories, under oath; (2) document requests nos. 1, 3 and 4; and (3) interrogatories nos. 1 and 2 in the second set of interrogatories, under oath. Further, applicant is

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<sup>4</sup> In particular, applicant has requested supplementation to opposer's response to interrogatory no. 1 inasmuch as the response is not supported by the Trademark Office records. This interrogatory is related to interrogatory no. 16 wherein applicant requests information regarding any possible assignments involving the pleaded marks. Opposer objected to interrogatory no. 16 as irrelevant and burdensome. The Board notes that these objections are not proper inasmuch as opposer has pleaded these marks and applicant is allowed to seek discovery regarding these marks. TBMP § 402.01.

<sup>5</sup> Information regarding licensees and license agreements is discoverable. TBMP § 414(10). See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988); *American College of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979).



Opposition No. 91159950

allowed **FORTY DAYS** from the mailing date of this order to notice and take the deposition of Mr. Leo Stoller on the issues of the validity and ownership of the marks asserted by opposer, and the alleged likelihood of confusion between those marks and applicant's mark. Applicant is allowed until **SIXTY FIVE DAYS** from the mailing date of this order to file its response to the motion for summary judgment.

Proceedings herein remain suspended pending disposition of opposer's motion for summary judgment in accordance with the Board's July 27, 2004 order.

Opposer is advised that proceedings will not be suspended with regard to these discovery obligations, notwithstanding any possible request for reconsideration or petition to the Commissioner. *Opticians Ass'n of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990), *rev'd on other grounds*, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).

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